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RICHARD MICHAEL NEMES 754 WEST BROADWAY WOODMERE, NY 11598-2948			BOVEJA, NAMRATA	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/790,991

Filing Date: March 02, 2004

Appellant(s): LOTVIN ET AL.

Mikhail Lotvin and Richard M. Nemes
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/24/2009 appealing from the Office action mailed 01/26/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,076,101 Kamakura et al. 06-2000

5,855,008 Goldhaber et al. 12-1998

Valupage.com print out from Internet Archive Wayback Machine 12-1998

Article titled “Points for Loyalty” Obendorf 12-1997

Official Notice

References cited in support of Official Notice:

6,618,747 Flynn et al. 09-2003

(9) Grounds of Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27, 75, 77, 79-81,83, and 84 are rejected under U.S.C. 103(a) as being unpatentable over Kamakura et al. Patent Number 6,076,101 (hereinafter Kamakura) in view of the article by Shannon Obendorf, titled “Points for loyalty,” from Catalog Age,

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December 1997, Vol. 14, Iss. 13, pg. 35 (hereinafter Obendorf) and further in view of Official Notice.

In reference to claims 27 and 80, Kamakura discloses a computer readable medium and method of providing advertisement to a user communicating with an advertising entity over a network, comprising: sending e-mail comprising an advertisement message identifying a monetary value associated with the advertisement (col. 1 lines 61 to col. 2 lines 13), wherein the monetary value is displayed in a subject line of the transmitted e-mail, which is displayed to the user before the e-mail is opened and a message in a body of the e-mail can be read (col. 3 lines 33-39 and 57-63 and col. 6 lines 20-22 and 62-67); and enabling the user to realize the monetary value associated with the advertisement, comprising the steps of: electronically providing the user with purchasing choices consistent with the monetary value (col. 9 lines 10-53).

Kamakura teaches the identification of bonus points in a subject line of the transmitted e-mail (col. 3 lines 33-39 and 57-63 and col. 6 lines 20-22 and 62-67). Kamakura does not specifically teach identifying advertised product or service and displaying the advertised product or service in a subject line of an e-mail. Official Notice is taken that it is old and well known to identify an advertised product or service in a subject line of the transmitted e-mail. For example, when a user receives e-mails from retailers, the subject line may say all DVD's on sale, business books on sale, fall coat sale, all shoes on sale, etc. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to have included identification information regarding an advertised product or service in a subject line of the transmitted e-mail to

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enable the user to know before opening the e-mail, if the e-mail is regarding a product that is of interest to the user at that given time.

Kamakura does not specifically teach receiving an automatically-generated response from computer of the user indicating that the user has opened the e-mail. Official Notice is taken that it is old and well known to receive an automatically-generated response from computer of the user indicating that the user has opened the e-mail. For example, when a user sends an e-mail using Microsoft Office, he can click on options and check the box for receiving a read receipt for the e-mail message he is sending to receive an e-mail letting him know that the recipient has opened the e-mail. Additionally, America Online provides the feature in the e-mail program called status, and when the user of an America Online e-mail account sends an e-mail to another user of an America Online e-mail account, the sender can click the button for status to know if the recipient has opened his e-mail. Also, marketers such as Intellipost Corp's BonusMail enable users to receive credit toward merchandise and services every time the user opens up a promotional e-mail and therefore inherently need to know that the user opened an e-mail to reward those credits. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to have included receiving an automatically-generated response from computer of the user indicating that the user has opened the e-mail to provide the user some incentive for simply opening an e-mail and additional incentives for taking an action regarding the advertising received by the user.

Kamakura does not specifically teach electronically determining the user's selection and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection. Obendorf teaches electronically determining the user's selection (page 1 paragraph 4, page 2 paragraph 7 and Figure 1, and page 3 paragraphs 1 and 3) and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection (page 1 paragraph 4, page 2 paragraph 7 and Figure 1, and page 3 paragraphs 1 and 3). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include electronically determining the user's selection and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection in Kamakura's invention to enable the users to redeem theirs points with retailers that offer products of interest to the users from the convenience of their home by using their computers to order their award items.

In reference to claims 75 and 81, Kamakura teaches the computer readable medium and the method further comprising transferring the monetary value specified in the e-mail to account of the user (col. 2 lines 8-13, col. 3 lines 10-13 and 43-48, and col. 8 lines 15-28).

In reference to claims 77 and 83, Kamakura teaches the computer readable medium and the method wherein the monetary value is displayed as points (abstract, col. 3 lines 1-56, col. 4 lines 24-31, col. 5 lines 1-7, col. 6 lines 58-67, col. 8 lines 24-28, and col. 9 lines 10-42).

In reference to claims 79 and 84, Kamakura does not teach the computer readable medium and the method further comprising electronically receiving a commission from the third-party supplier of goods or services. Obendorf teaches the computer readable medium and the method further comprising electronically receiving a commission from the third-party supplier of goods or services (i.e. Edmund Scientific sells products to MotivationNet at a discount, and they buy MyPoints for \$0.016 per point and MotivationNet buys back redeemed points for \$.01) (page 2 paragraph 6). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Kamakura's invention electronically receiving a commission from the third-party supplier of goods or services to enable the reward program administrator to generate revenues by bringing business to third-party suppliers of goods or services by introducing new customers to the third-party suppliers.

Claims 28 and 85 are rejected under U.S.C. 103(a) as being unpatentable over Kamakura in view of Oberndorf and further in view of Official Notice and further in view of the Valupage.com website (www.valupage.com) (from date 12/03/1998 captured by the Wayback Machine Internet Archives) (hereinafter Valupage).

In reference to claims 28 and 85, Kamakura teaches the use of conditions in determining the transfer amount of monetary value to the user's account (col. 5 lines 24 to col. 6 lines 11 and col. 7 lines 30 to col. 9 lines 9). Kamakura is silent about teaching specifying an expiration date after the monetary value associated with the advertisement expires. ValuPage teaches specifying an expiration date (i.e. the savings are just for this week, even though an expiration date is not written out on this printout, it

is inherent that when it is stated on the print out that these are the ValuPage savings for this week, this week is a duration of a week, and the offers expire at the end of the week when next week's ValuPage will be released) (see ValuPage print out lines 8 and 9). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include specifying an expiration date after the monetary value associated with the advertisement expires in Kamakura's invention for the advertising messages to encourage the user to quickly redeem the offer, to maintain an accurate record of how many credits have been rewarded for a given campaign during a specific time period, and to make sure the user can access the information in a meaningful timeframe. And, even though the ValuPage invention is depicted as being carried out on a website in the printed embodiment, it could have easily been pasted in the body of the e-mail message itself.

Claims 76 and 82 are rejected under U.S.C. 103(a) as being unpatentable over Kamakura in view of Oberndorf and further in view of Official Notice and further in view of Goldhaber et al. Patent Number 5,855,008 (hereinafter Goldhaber).

In reference to claims 76 and 82, Kamakura teaches the computer readable medium and the method wherein the monetary value is displayed as points (abstract, col. 3 lines 1-56, col. 4 lines 24-31, col. 5 lines 1-7, col. 6 lines 58-67, col. 8 lines 24-28, and col. 9 lines 10-42). Kamakura does not specifically teach displaying the point value as currency. Goldhaber teaches displaying the point value as currency (col. 7 lines 5-11 and 51-54, col. 12 lines 55-61, and col. 16 lines 12-23). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to

include in Kamakura's invention the display of the monetary value as currency to enable the users to know how many award dollars they are spending on a given award so that that the user can compare the dollar award value to what the item might cost in a store easily rather than having to try to convert how many points equate a dollar value of the item in a store.

(10) Response to Argument

Regarding claims 27 and 80, the Applicant argues that the Examiner's Official Notice regarding the limitation of identifying advertised product or service in the subject line of an e-mail relate to the current state of the art and not the state of the art prior to the effective filing date of the present application. With respect to this argument, Kamakura teaches the identification of bonus points in a subject line of the transmitted e-mail (col. 3 lines 33-39 and 57-63 and col. 6 lines 20-22 and 62-67). This information is being displayed in the subject line before the user opens the e-mail. The content of the information being handled by the system is non-functional descriptive material which cannot be distinguished from the prior art. The point is to communicate some information to the user before the user opens the e-mail. What that information textually represents is just data per se. Furthermore, the Examiner has given several examples to the Applicant to show that it is old and well known to identify an advertised product or service in a subject line of the transmitted e-mail. For example, when a user receives e-mails from retailers, the subject line may say all DVD's on sale, business books on sale, fall coat sale, all shoes on sale, etc. It would have been obvious to a person of ordinary

skill in the art at the time of the applicant's invention to have included identification information regarding an advertised product or service in a subject line of the transmitted e-mail to enable the user to know before opening the e-mail, if the e-mail is regarding a product that is of interest to the user at that given time.

Regarding claims 27 and 80, Applicant also argues that the Examiner's Official Notice for the limitation of receiving an automatically-generated response from the computer of the user indicating that the user has opened the e-mail relates to the current state of the art and not the state of the art prior to the effective filing date of the present application. The Examiner has found the Flynn patent as further evidence in support of the Official Notice. Specifically, col. 3 lines 6-17, col. 5 lines 58 to col. 6 lines 8, and col. 6 lines 22-24 and 53-65 teach automatically notifying a sender of an e-mail that the recipient has retrieved and opened the e-mail. Furthermore, the Examiner has given several examples to show that it is old and well known to receive an automatically-generated response from computer of the user indicating that the user has opened the e-mail. For example, when a user sends an e-mail using Microsoft Office, he can click on options and check the box for receiving a read receipt for the e-mail message he is sending to receive an e-mail letting him know that the recipient has opened the e-mail. Additionally, America Online provides the feature in the e-mail program called status, and when the user of an America Online e-mail account sends an e-mail to another user of an America Online e-mail account, the sender can click the button for status to know if the recipient has opened his e-mail. Also, marketers such as Intellipost Corp's BonusMail enable users to receive credit toward merchandise and

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services every time the user opens up a promotional e-mail and therefore inherently need to know that the user opened an e-mail to reward those credits. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to have included receiving an automatically-generated response from computer of the user indicating that the user has opened the e-mail to provide the user some incentive for simply opening an e-mail and additional incentives for taking an action regarding the advertising received by the user.

Regarding claims 27 and 80, Applicant argues that the MyPoints site described in the Obendorf reference does not offer purchasing selections which when made are fulfilled by a third party, and there is no teaching in Obendorf of all 3 steps of (1) electronically providing the user with purchasing choices consistent with the monetary value; (2) electronically determining the user's selection; and (3) electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection. The Examiner respectfully disagrees with the Applicant, since Obendorf teaches the fulfillment of purchasing selections by a third party, i.e. a participating catalog Website such as Edmund Scientific where users redeem their MyPoints to obtain items from the Edmund Scientific catalog website (see page 1 paragraphs 3 and 4 and page 2 paragraphs 7 and Figure 1). Furthermore, Kamakura teaches the step of (1) electronically providing the user with purchasing choices consistent with the monetary value (col. 9 lines 10-53), and Obendorf teaches the steps of (2) electronically determining the user's selection (page 1 paragraph 4, page 2 paragraph 7 and Figure 1, and page 3 paragraphs 1 and 3); and (3) electronically providing the user's selection to

a third-party supplier of goods or services consistent with the user's selection (page 1 paragraph 4, page 2 paragraph 7 and Figure 1, and page 3 paragraphs 1 and 3). The Examiner would like to point out to the Applicant that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references (**Kamakura and Obendorf**). See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is the combination of these references that addresses the claim limitations, and therefore, each reference will not teach all the limitations on its own.

In reference to claims 28 and 85, Applicant argues that the Kamakura reference teaches away from the ValuPage reference because Kamakura involves sending a message directed to a particular person and ValuPage deals with posting an advertisement on a website not specific to a particular person, so they should not be combined. With respect to this argument, the Examiner respectfully disagrees with the Applicant. A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. Thus, the question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis. *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 47 USPQ2d 1516 (Fed. Cir. 1998). Additionally, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. *In re Susi*, 169 USPQ 423 (CCPA 1971). While it may be preferred to have one way of displaying advertisements to customers via a website, this does not mean that there can only be one way of accomplishing this task. For example, you can also e-mail the weekly advertisements to individual

customers who have provided an e-mail address. Just because you can accomplish a task one way does not mean that you can't do this another way, and accomplishing the task by two different ways does not mean one way teaches away from another way. Furthermore, per *KSR*, known work in one field of endeavor may prompt variations of it for use in either the same filed or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. Here, if other advertisers such as supermarkets expire their advertising offers to users on a weekly basis, Kamakura would be motivated to do the same to encourage users to quickly redeem offers, to maintain an accurate record of how many credits have been rewarded for a given campaign during a specific time period, and to make sure the user can access the information in a meaningful timeframe.

Regarding claims 28 and 85, the Applicant also argues that the ValuPage reference does not imply any expiration date, since if \$42 in savings are available in a given week does not mean the discount is good for one week and that it would not be available in the next week. The Examiner respectfully disagrees with the Applicant, since ValuPage teaches that the \$42 in savings are with this week's ValuPage. So, they are for this particular week and therefore have a timeframe attached with them. While the Examiner agrees with the Applicant that some of these offers may show up again in next week's ValuPage, but that does not mean that the offers as presented are not valid for a timeframe of one week. Additionally, nothing in ValuPage suggests that these offers will actually be repeated for next week. As far as a user is concerned, these offers are only valid for that week, since even if some of them are going to be

repeated the following week, the user will not know that at the present time. ValuPage teaches specifying an expiration date (i.e. the savings are just for this week, even though an expiration date is not written out on this printout, it is inherent that when it is stated on the print out that these are the ValuPage savings for this week, this week is a duration of a week, and the offers expire at the end of the week when next week's ValuPage will be released) (see ValuPage print out lines 8 and 9).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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